

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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| Applicant: | Hardison, Pamela |) | Docket: | 06-0320-PHA.RA |
| | |) | | |
| Serial No.: | 10/674,758 |) | Examiner: | Flick, Jason E |
| | |) | | |
| Filed: | September 30, 2003 |) | Group Art Unit: | 3763 |
| | |) | | |

For: **DEVICE AND METHOD FOR SUPPORTING WOUND
DRAINAGE SYSTEMS**

Dated: July 22, 2011

Mail Stop – Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Appellant submits the following Reply Brief pursuant to 37 C.F.R. §41.41(a)(1) for consideration by the Board of Patent Appeals and Interferences, and in response to the Examiner's Answer mailed June 8 , 2010.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is submitted via EFS-Web on: July 22, 2011

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July 22, 2011
(Date)

I. STATUS OF CLAIMS

Applicant's claims 1-20 and 22, submitted April 6, 2010 in response to the Examiner's Non-final Office Action of January 19, 2010, are pending and rejected. Claim 21 has been withdrawn from consideration.

II. RESPONSE TO EXAMINER'S ARGUMENT IN THE ANSWER

In addition to the arguments provided in the Appellant Appeal Brief filed March 7, 2011, the Appellant provides the following remarks regarding the Examiner's Answer mailed June 8, 2011.

35 U.S.C § 112 REJECTIONS

Claims 1, 14, and 22 claim an upper section and a lower section which are uniform in diameter. In the Office Action mailed July 7, 2010, the Examiner rejected claims 1, 14 and 22 under 35 U.S.C. § 112, first paragraph, because they "contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

“[T]hat a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment.” *In re Rasmussen*, 650 F.2d 1212, 1215 (C.C.P.A. 1981). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. MPEP 2161(III)(A). (citing *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971).

Instead of presenting such evidence, the Examiner impermissibly requires a verbatim recitation of the claims in the Specification. However, ***“there is no need for a verbatim description of every claimed embodiment.”*** *In re Hunter*, 1995 U.S. App. LEXIS 15363, 15380 (Fed. Cir. 1995) (Emphasis added) (citing *In re Edwards*, 568 F.2d 1349, 1351-52 (CCPA 1978)). Instead, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. MPEP 2163.02 (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)).

The Specification both addresses and proposes a solution to the problem of the splice having a diameter inconsistent with the length of material, and such awareness of the entire invention having a uniform diameter shows that, at the time the instant application was filed, Applicant was aware of and

reasonably conveyed the upper and lower sections having uniform diameters. On page 9, lines 18-20 the Specification states recites that “the invention is preferably a soft flexible length of material ... spliced so as to complete the circle in a fashion that does not increase the diameter of the spliced area.” On page 10, lines 14-16, the Specification recites that “preferably, splice **30** is smooth and has substantially the same diameter **32** as the diameter **26** of length of material **20**.” These disclosures in the Specification clearly convey that, at the time of filing the instant patent application, Applicant was aware of the potential importance of the *entire* invention having a uniform diameter, and so described her invention. These disclosures clearly convey to one skilled in the art that, at the time the instant patent application was filed, Applicant possessed the idea of the upper and lower sections having uniform diameters.

Further, Applicant describes length of material **20** as having a diameter **26**, and the length of material **20** is preferably formed into a shape that it creates upper loop **40**, bottom **60**, and lower doubled section **50**.¹ Therefore, upper loop **40**, bottom **60**, and lower doubled section **50** inherently must have the same, and thus a uniform diameter **26**.

Finally, claim 7, which indirectly depends on claim 1 and was filed with the original patent application on September 30, 2003, recites “said splice has a

¹ Specification, page 10, lines 18-20.

diameter and said length of material has a diameter, and wherein said splice diameter is approximately equal to said length of material diameter.” Disclosure in an originally filed claim can satisfy the written description requirement², and claim 7 implicitly recites the length of material having a *single, uniform diameter*, which is thus descriptive of the upper section and the lower section.

Applicant has clearly demonstrated that Applicant had possession of an embodiment of the invention in which the upper section and lower section have a uniform diameter. Accordingly, for the above reasons, the Examiner’s rejection of claims 1, 14 and 22 under 35 U.S.C. § 112, paragraph 1, should be overturned.

35 U.S.C § 103(a) REJECTIONS

“It is well settled that the PTO ‘bears the initial burden of presenting a prima facie case of unpatentability.’”³ Because all of the elements in the claims are not disclosed in the cited references, the Examiner has not met this burden.

1. Chu teaches a uniform thickness, not a uniform diameter

² *Union Oil Co. of Calif. v. Atlantic Richfield Co.*, 208 F.3d 989, 998 n.4 (Fed. Cir. 2000) (citing *In re Gardner*, 480 F.2d 879, 880 (C.C.P.A. 1973)).

³ *In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007), citing *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002)).

In the Final Office Action, mailed July 7, 2010, the Examiner referred to Chu et al. '181 to supply the element of upper and lower sections that are uniform in diameter. However, as the Examiner conceded in the Advisory Action mailed February 2, 2011, Chu et al. '181 merely teaches a sling that may have a uniform *thickness*.

The Examiner is arguing that the word “thickness” is subsumed by the word “diameter”. Not only is this argument counter-intuitive, it is contrary to established rules regarding claim construction. Claim terms should be interpreted as a person having ordinary skill in the art would interpret them.⁴ Thickness is NOT diameter, and a person having ordinary skill in the art would not interpret such to be so. Accordingly, Chu et al. '181 does not supply the missing requirement of a “uniform diameter” as required by Applicant’s independent claims 1, 14 and 22, and therefore the rejection as to claims 1, 14 and 22, and all claims depending therefrom, should be overturned.

2. Chu et al. '181 does not teach an upper and lower section that are “uniform in diameter”

In the Final Office Action of July 7, 2010, the Examiner claims that “Chu teaches a support apparatus comprising upper and lower sections wherein the

⁴ *Festo Corp., v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 123 S.Ct. 70 (2002).

material is uniform in diameter (FIG. 3, item 16, paragraph [0035]).” However, instead of teaching an upper section and a lower section having a uniform diameter, Chu ‘181 teaches a “sling **16** [that] may have a uniform thickness over the entire length and/or width of sling **16**.”⁵

The Examiner cannot pull out of the air a structure and function where there is none taught⁶. The sling in Chu ‘181 is a *single component* that, as far as Applicant can determine, does not comprise any subcomponents. Therefore, Chu ‘181 does not teach a length of material joined together so as to form an upper section and a lower section, wherein said upper section and said lower section are uniform in diameter. Rather than address this argument in the Examiner’s Answer, the Examiner conveniently decided to ignore this important distinction.

3. Dependent claim 7

Claim 7, which indirectly depends from claim 1, recites “wherein said splice has a diameter and said length of material has a diameter, and wherein said splice diameter is approximately equal to said length of material diameter.”

⁵ Chu et al. ‘181, paragraph [0035].

⁶ In *Ex parte Yoshida*, the Board found “that the Examiner is speculating and extrapolating from beyond the disclosure.” *Ex parte Yoshida*, 2002 Pat. App. LEXIS 215, 216-219 (Pat. App. 2002).

In the Final Office Action mailed July 7, 2010, the Examiner relies on FIG. 1 in Chu '181 to teach this element.

However, as the Examiner stated *in the same Final Office Action*, “figures may not be used to show support for limitations relating to scale/relative size of elements (MPEP 2125).”⁷ An examination of FIG. 1 in Giacona, III '181 reveals that the stitching appears to be noticeably larger than the cable. Furthermore, Giacona, III '181 teaches that the “cable 27 [which is being attached to strap 11] is *preferably a much smaller diameter* than the maximum thickness of large loop member 11.”⁸ Contrary to teaching “said splice diameter [being] approximately equal to said length of material diameter,” *as is required to sustain the Examiner’s § 103(a) rejection*, if Giacona, III '181 teaches anything, it teaches a splice diameter that is necessarily different than the diameter of the materials.

In response, the Examiner notes that “approximately equal to” does not require exactly equal⁹. This may be true, but that does not mean that any two *disproportionate* objects can be held to teach “approximately equal”. Therefore, the Examiner’s dependence on Giacona, III '181 as to the rejection of claim 7 is misplaced, and the rejection as to claim 7 should be overturned.

⁷ Office Action, page 2, mailed July 7, 2010.

⁸ Chu et al. '181, paragraph [0109] (Emphasis added).

⁹ Examiner’s Answer, page 12, filed June 8, 2011.

CONCLUSION

In light of the aforementioned arguments, the Examiner has clearly erred with respect to the patentability of the claimed invention. It is respectfully requested that the Board overturn the Examiner's rejection of all pending claims and hold that the claims satisfy the requirements of 35 U.S.C. §§ 103(a), 112.

Respectfully submitted, this 22nd day of July, 2011,

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